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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,523	10/11/2001	Masayuki Yoshida	HSTI 0128 PUS	2369
35312	7590	11/24/2003	EXAMINER	
BROOKS KUSHMAN P.C./ HENKEL CORPORATION 1000 TOWN CENTER TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075-1238			TARAZANO, DONALD LAWRENCE	
		ART UNIT		PAPER NUMBER
		1773		

DATE MAILED: 11/24/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/975,523	YOSHIDA ET AL.	
Examiner	Art Unit		
D. Lawrence Tarazano	1773		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 11 August 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 14-25 and 27-30 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 14-25, 27-30 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
 

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. 09/230,872.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION*****Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 14-25, and 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoki et al. (WO-95/28509).

3. Aoki et al. teach an aqueous coating composition comprising a water-soluble polymer (I) corresponding to the applicants' claimed structure (applicants' I and Y<sup>1</sup> together) including the additional amine functionality (II) corresponding to the claimed (II). The ratio of the components falls within the claimed range (page 8, lines 21-26). The examples show the addition of phosphoric acid compounds (phosphoric acid and sodium phosphate), in amounts that would meet the applicants' limitations in this regard.

4. The applicants claim that the coating has a polymer concentration of 0.01 g/L and the coating has a carbon content of 5-500 mg/m of the coating area. Aoki et al. teach polymer concentrations amounts of **about 2 g/liter** or greater according to the examples (see also column 4, lines 25+).

5. The method of formation taught in Aoki et al. is not unlike that claimed (see page 12, lines 1+, and the examples), in which the coating is washed with water then dried.

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6. However, Aoki et al. is silent regarding the thickness of the coatings and the amount of carbon present. Nevertheless, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have varied the concentration of the components used, depending on the thickness of the coating desired, or to have coated the metal with multiple layer as in example 4, depending on the thickness of the desired for a given application, in which the claimed amount of carbon and claimed extent of area coverage flows from the thickness of the layer produced since the same type of polymer and concentration is used thus 90% of the surface would be covered as claimed.

***Response to Arguments***

7. Applicant's arguments filed 8-11-2003 have been fully considered but they are not persuasive.

8. The applicants amended the claims to recite that the coating comprises 0.01 g/L to 2.0 g/L of polymer (I), the examiner notes that this value still overlaps with the range of 2.0 g/L or greater suggested in the prior art (WO-95/28509).

9. The examiner is not convinced by the applicants' allegations of unexpected results with respect to the concentration. It appears that none of the comparative examples (CE 1-4, page 20) contain any of the claimed polymer (I). Furthermore, Examples 5-7 each contain greater than 2 g/L of polymer 3, which corresponds to (I). In the results in table 2, there does not appear to be any difference in the behavior of the examples (1-7), which includes both amounts within the claimed range and outside of the claimed range.

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10. It is not clear what element the applicants are relying on for comparative data, which shows the alleged unexpected results.

In the absence of clear evidence to the contrary, the examiner maintains that it would have been obvious to one having ordinary skill in the art at the time the invention was made to have varied the concentration of the components used, depending on the thickness of the coating desired, or to have coated the metal with multiple layer as in example 4, depending on the thickness of the desired for a given application, in which the claimed amount of carbon and claimed extent of area coverage flows from the thickness of the layer produced since the same type of polymer and concentration is used thus 90% of the surface would be covered as claimed .

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The examiner cites: US 6369149-B1 (Yoshida et al).

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Lawrence Tarazano whose telephone number is (703)-308-2379. The examiner can normally be reached on 8:30 to 6:00 (off every other Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J Thibodeau can be reached on (703)-309-2367. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9310 for regular communications and (703)-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-0661.

D. Lawrence Tarazano  
Primary Examiner  
Art Unit 1773

dlt  
October 30, 2003